

### **REMARKS**

Applicants reply to the Final Office Action mailed on May 31, 2005, within two months. Thus, Applicants request an Advisory Action, if necessary. Claims 1-4, 7-15, 19, 23-44 and 46-62 were pending and the Examiner rejects claims 1-4, 7-15, 19, 23, 30-44 and 46-62, and claims 24-29 are allowable. In reply, Applicants amend various claims, cancel claim 44 without prejudice to filing one or more applications including claims with similar subject matter, and address the Examiner's remarks. Support for the amendments may be found in the originally-filed specification, claims, and figures. Specifically, the limitation of a "through portion of which is substantially transmissive to visible light" was originally presented, for example, in claims 39 and 40. No new matter has been introduced by these amendments. Reconsideration of this application is respectfully requested.

Applicants thank the Examiner for the courtesies extended in the interview on June 28, 2006.

Applicants respectfully assert that the subject matter of the various claims was commonly owned at the time the inventions covered therein were made and therefore, Applicants have complied with 37 C.F.R. § 1.56.

### **Double Patenting**

The Examiner provisionally rejects claims 39, 40, 51, 57, and 58 over claim 1 of U.S. Patent No. 6,581,839. While Applicants respectfully disagree with this double patenting rejection, in the interest of compact prosecution, Applicants submit a terminal disclaimer, without prejudice, in compliance with 37 C.F.R. § 1.321(c). Applicants also assert that this provisional non-statutory double patenting rejection is based on the above-listed patent, which is commonly owned with this application by assignee, American Express Travel Related Services Company, Inc.

### **Claim Rejections - 35 USC § 102**

Claims 1, 2, 4, 9-11, 13, 14, 30, 33-36, 43, 47-49, 54-56, 59, 60, and 62 stand rejected under 35 U.S.C. § 102(e) as being unpatentable over Tuttle et al. U.S. Pat. No. 5,988,510 ("Tuttle"). Applicants respectfully traverse.

Tuttle teaches a multi-layered transaction card having transponder circuitry and expressly teaches that "such layers are provided to a degree to effect a complete opacity such that

conductive inks and circuitry components (described below) are not viewable through the front of the card.” (col. 7, lines 47-51) (emphasis added). Thus, Tuttle does not disclose or suggest at least a card, “a through portion of which is substantially transmissive to visible light, comprising: [a] machine recognizable compound substantially uniformly associated with said portion of said card,” as recited in independent claims 1 and 33, or as similarly recited in independent claims 36, 37, 39, 40, 41, 42, and 62. The limitation of “through portion of which is substantially transmissive to visible light” was originally presented in claims 39 and 40 and has now been added to each of the independent claims to address the Examiner’s argument, and discussion in the Examiner interview, that these claims earlier read on a single transparent layer over an opaque card.

Accordingly, Applicants assert that claims 1, 33, 36, 37, 39, 40, 41, 42, and 62 are patentable over the cited references. Claims 2, 4, 9-11, 13, 14, 30, 35, 43, 47-49, 54-56, 59, 60, and 62 variously depend from claims 1 and 33, 37, 39, 40, 41, 42 and contain all of the respective elements thereof. Therefore, Applicants respectfully submit that these dependent claims are likewise differentiated from the cited references at least for the same reasons as set forth above, in addition to their own respective features. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 2, 4, 9-11, 13, 14, 30, 33-36, 43, 47-49, 54-56, 59, 60, and 62.

**Claim Rejections - 35 USC § 103**

Claims 7, 8, 12, 23, 44, and 46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tuttle. Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Tuttle in view of Koshizuka et al. U.S. Pat. No. 5,407,893 (“Koshizuka”). Claim 15 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Tuttle in view of Blumel et al. U.S. Pat. No. 4,672,021 (“Blumel”). Claims 19, 37, 38, 41, 42, 52, 53, and 61 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tuttle in view of Riedl U.S. Pat. No. 5,928,788 (“Riedl”). Claim 31 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Tuttle in view of Stock et al. U.S. Pat. No. 6,011,858 (“Stock”). Applicants respectfully traverse.

While the cited references generally disclose various transaction card constructions, neither Tuttle, Koshizuka, Blumel, Riedl, Stock, nor any combination thereof, disclose or suggest at least a card, “a through portion of which is substantially transmissive to visible light, comprising: [a] machine recognizable compound substantially uniformly associated with said

portion of said card,” as recited in independent claims 1 and 33, or as similarly recited in independent claims 36, 37, 39, 40, 41, 42, and 62.

Accordingly, Applicants assert that claims 1, 33, 36, 37, 39, 40, 41, 42, and 62 are patentable over the cited references. Claims 3, 7, 8, 12, 15, 19, 23, 31, 38, 46, 52, 53, and 61 variously depend from claims 1 and 33, 37, 39, 40, 41, 42 and contain all of the respective elements thereof. Therefore, Applicants respectfully submit that these dependent claims are likewise differentiated from the cited references at least for the same reasons as set forth above, in addition to their own respective features. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 3, 7, 8, 12, 15, 19, 23, 31, 37, 38, 42, 46, 52, 53, and 61.

**CONCLUSION**

Applicants respectfully submit that the pending claims (52 total, 9 independent) are in condition for allowance. Reconsideration of the application is thus requested. The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. 19-2814. Applicants invite the Examiner to telephone the undersigned if the Examiner has any questions regarding this Reply or the application in general.

Respectfully submitted,

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